

**REMARKS**

With this amendment, claims 1-5 and 11 remain pending in the application. Claim 12 has been cancelled. Currently, claims 1-5 remain rejected under 35 U.S.C. §103(a) over Saad et al. (U.S. Patent 5,562,874) in view of Satoh et al. (U.S. Patent 6,194,061 B1). Claim 11 remains rejected under 35 U.S.C. §103(a) over Omura et al. (U.S. Patent 4,650,847).

With respect to claims 1-5, reconsideration of the rejection under 35 U.S.C. §103(a) over Saad et al. in view of Satoh et al. is respectfully requested on the basis that one skilled in the art would not be motivated to make the combination of Saad et al. in view of Satoh et al. detailed in Paper No. 9, paragraph 14, for the reasons stated hereinbelow. Saad et al. teaches the formation of multi-layer films containing a volatile antioxidant only through film coextrusion (i.e. column 2, lines 15, 35, 39 and 43; column 3, line 66 – column 4, line 4; and column 4, lines 19-27). Blown film coextrusion as known to one skilled in the art makes possible the combination of materials with different properties to create a finished product most suitable for a particular application. One skilled in the art would appreciate that film coextrusion involves the simultaneous extrusion of at least two molten streams of different plastic materials from proximal dies at a rate and in proximity to assure the formation of a laminar structure.

The polyester graft copolymer (A) and resin (B) according to Satoh et al. that are reacted in the presence of a curing agent to form an adhesion layer according to Satoh et al. Applicant submits that one skilled in the art would recognize that a graft polymerization mixture according to Satoh et al. is simply incompatible with the coextrusion process detailed by Saad et al. and therefore would lack motivation to modify the composition of Saad et al. with the polyester urethane of Satoh et al. The polyester graft copolymer (A) according to Satoh et al. is detailed to be in the form of a dispersion or solution in an organic or aqueous solvent. (Column 7, lines 42-52). The resin (B) is added in a variety of ratios (column 12, lines 47-50) and with a cross

linking agent present the dispersion or solution is applied to a thermoplastic film substrate and dried during which time cross linking occurs, resulting in a solid content film of 1 to 50 weight percent of the initial dispersion or solution (column 17, lines 33-42).

Assuming for argument's sake that one replaced the middle (antioxidant) layer feedstock of Saad et al. with a solution or dispersion of polyester copolymer (A) and resin (B) according to Satoh et al. and attempted blown film coextrusion according to Saad et al., such an attempt would yield only failure. The reasons for failure include the inability to evaporate organic or aqueous solvent through the adjacent sandwiching layers, the inability of polymerization to occur in concert with adjacent layer solidification under blown film coextrusion techniques based on the teachings of Satoh et al., and antioxidant volatilization associated with the heat of blown film coextrusion and even limited time exposure to air (see Saad et al., column 1, lines 32-67). With regard to antioxidant volatilization, heating is taught by Satoh et al. to speed drying and heating is always associated with blown film coextrusion. The notion of passive drying at room temperature or with moderate heating as detailed in Paper No. 11 as being an option is simply incompatible with multi-layer film formation according to Saad et al.

It is well established law with respect to an obviousness rejection that one skilled in the art must find both a suggestion for the combined reference combination and a reasonable expectation of success. The court stated in *In re Vaeck*:

Where claimed subject matter has been rejected as obvious in view of a combination of prior art references, a proper analysis under Section 103 requires, *inter alia*, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success.

*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

For the reasons stated above with respect to blown film coextrusion, one skilled in the art would not have a reasonable expectation of success in attempting to create the subject matter of claims 1-5 through the prior art reference combination of Saad et al. and Satoh et al. To take a contrary position is submitted to represent picking and choosing among the individual elements of the prior art references of record, and such an approach is contrary to the law regarding obviousness. *Symbol Technologies, Inc. v. Opticon, Inc.*, 935 F.2d 1569, 19 USPQ2d 1241 (Fed. Cir. 1991).

In view of the above remarks, Applicant asserts that one skilled in the art would not undertake the proposed reference combination and further, if one were to do so, the claimed invention would not be achieved. Reconsideration of the rejection of claims 1-5 under 35 U.S.C. §103(a) over Saad et al. in view of Satoh et al. is requested.

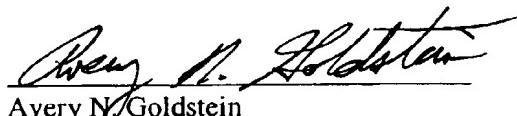
Claim 11 has been amended to now recite a product-by-process claim indicating that the adhesive resin applied is applied in a solventless form as opposed to applying a solvated adhesive that is subsequently dried on the substrate as per Satoh et al. As the prior art combination of Omura et al. and Satoh et al. is completely lacking in a teaching of solventless application of resin, it is respectfully submitted that claim 11 is now in allowable form. Reconsideration of the rejection of claim 11 under 35 U.S.C. §103(a) over Omura et al. in view of Satoh et al. is requested.

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Summary

Claims 1-5 and 11 are pending in this application. Claim 11 has been amended and claim 12 has been cancelled. Entry of this amendment is requested. Reconsideration and allowance of the pending claims is also solicited.

Respectfully submitted,



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